



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671
28710	7590	10/31/2007	EXAMINER	
PETER K. TRZYNA, ESQ.			CHANKONG, DOHM	
P O BOX 7131			ART UNIT	PAPER NUMBER
CHICAGO, IL 60680			2152	
			MAIL DATE	DELIVERY MODE
			10/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/385,802

Applicant(s)

BARTHOLOMEN DONOVAN,
KEVIN REMINGTON JOS

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20, 22, 103 and 105-151 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20, 22, 103 and 105-151 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1> This action is in response to Applicant's request for continued examination, filed 7.9.2007 and Applicant's supplemental amendment filed on 8.16.2007. By way of Applicant's amendment of 7.9.2007, claims 16 and 145 have been amended. By way of Applicant's amendment of 8.16.2007, claim 16 has been amended.

2> Claims 16-20, 22, 103 and 105-151 are presented for further examination. This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7.9.2007 has been entered.

Oath/Declaration

4> The Rubin declaration ["Rubin"] under 37 CFR 1.132 filed October 12, 2006 is insufficient to overcome the rejection of claims 16-20, 22, 103, 105-111, 118-121 and 125-127 based upon Aravamudan and Gudjonsson as set forth in the last Office action. Each of Rubin's statements are addressed in turn:

Art Unit: 2152

a. Rubin states that U.S law would have discouraged one of ordinary skill in the art from combining multi-realm instant messaging and encryption. (Rubin's declaration, pg. 2). Rubin further states that adding encryption to multi-realm instant messaging would have added too many complications that providers would have avoided using encryption.

Whether or not the legal atmosphere of the time was conducive to encryption of multi-realm instant messages does not relate to technological obviousness. The analysis for obviousness focuses on whether one of ordinary skill in the art, looking at the Aravamudan and Gudjonsson references, would have been motivated to combine them to arrive at Applicant's claimed invention.

b. Next, Rubin asserts that one of ordinary skill in the art would not have had a reasonable expectation of success in combining the references because the U.S. government prevented cryptographic systems that used 128-bit keys. (Rubin, pg. 2). Rubin discusses this in context of Netscape's web browser in 1991.

It is unclear how these facts relate to the combination of Aravamudan's multiprotocol messaging system and Gudjonsson's teaching of encrypting messages. The references were not relied upon to teach web browser technology, SSL-encrypted messages, or 128-bit keys.

c. Rubin then asserts that applying encryption to an instant messaging system would have been contrary to the accepted wisdom in the art in 1999, that multi-realm encryption would not have been expected, and that applied cryptography was a

Art Unit: 2152

specialized and burgeoning field (Rubin, pg. 3). Rubin does not provide any factual basis to support these conclusory assertions so they are afforded little weight.

d. Rubin asserts that encrypting over different “realms” was a source of much contention. Whether or not the service providers would have allowed encrypting over different realms (as Rubin asserts) and whether or not it would have been possible to encrypt over different realms are different issues.

e. Rubin asserts that service providers would have been reticent to develop any technologies that would narrow the scope of their business. (Rubin, pgs. 3-4). Of course, service providers were not the only inventors at the time of Applicant’s invention. Rubin’s statements do not relate to a general person of ordinary skill in the art.

f. Finally, Rubin argues that Gudjonsson does not disclose encryption to keep communication between two or more parties private and kept secret from other clients and from the messaging server. (Rubin, pg. 4). Rubin’s statements are arguing limitations not in the claimed invention. The claim merely recites encrypting between devices.

5> The Hollaar declaration [“Hollaar”] under 37 CFR 1.132 filed October 12, 2006 is insufficient to overcome the rejection of claims 16-20, 22, 103, 105-111, 118-121 and 125-127 based upon Aravamudan and Gudjonsson as set forth in the last Office action. The declaration under 37 CFR 1.132 filed October 12, 2006 is insufficient to overcome the rejection of claims 112 and 113 based upon Auerbach and Gudjonsson as set forth in the last Office action.

Art Unit: 2152

It is noted that Hollaar does not expressly address the rejection of claims 16, 22, 105-108, 118, 122, 125 and 149 are rejected under 35 U.S.C § 103(a) as being unpatentable over Auerbach in view of Kim, U.S Patent No. 6,490,274 ["Kim"], in further view of Gudjonsson.

The Hollaar declaration is insufficient for the following reasons:

a. Hollaar asserts that Aravamudan does not disclose first and second users being associated with a first realm and a second realm. Hollaar focuses on Aravamudan's teaching of a circuit switched network (PSTN) and argues that such a network is "not at all like the packet-switched Internet." (Hollaar, pg. 3).

Hollaar simply seems to be asserting that since Aravamudan discloses a circuit switched network, it cannot teach conducting an instant messaging session over the Internet. But Aravamudan is not limited to only circuit switched networks, discussing throughout the specification the use of instant messaging over the Internet [column 3 «lines 37-41»].

Aravamudan allows users of one realm (those in the PSTN network) to communicate with users of a second realm (those in the regular packet-switched network) by converting the instant messages of users from one protocol to another [column 3 «lines 53-63»].

b. Hollaar also asserts that Gudjonsson does not teach "user of encryption between the two users." (Hollaar, pg. 3). This is not a claimed limitation and therefore Hollaar's assertions are not germane to the rejection of the claimed invention.

In any event, as noted by Hollaar, Gudjonsson discloses that encryption takes place between clients and servers. This however does not mean that the communications between the clients (instant messaging) is not encrypted as well. The whole purpose of Gudjonsson's invention is to "broker services between two or more users" [abstract].

It would have been reasonable for one ordinary skill to infer that when a first client communicates with a second client, the entire pathway from the first client to the server to the second client is encrypted because the connections between the first and second clients to the server are encrypted.

c. Next, Hollaar argues that it would not have been obvious to combine the references asserting that there is no indication of a reference that teaches having secured transmission of network messages between users. (Hollaar, pg. 4). However, the burden of obviousness can also be satisfied by knowledge generally available to one of ordinary skill in the art.

To assert that one of ordinary skill in the art would not be motivated to have secure communications over the Internet is counterintuitive. Indeed, Gudjonsson expresses a benefit of encrypting messages as preventing mischievous parties from breaching the communications [column 11 «lines 40-43»]. This would provided enough motivation for any one of ordinary skill to begin implementation of encryption technology within Aravamudan's system.

Art Unit: 2152

d. Finally, Hollaar attempts to distinguish the Auerbach reference over claims 112 and 113. Again, it is noted that Hollaar does not discuss Auerbach with reference to the rejection of claims 16-20, 22, 103, 105-111, 118-121 and 125-127.

Hollaar's statements refer to "a single IM manager" in attempting to distinguish Auerbach. Claims 112 and 113 merely recite retrieving an instant messaging protocol from a database that is accessible to the first user. Hollaar's attempt to distinguish Auerbach from the claimed invention is not persuasive.

Auerbach's protocol modules are part of a single device, the conversion platform. The Office interprets Auerbach's conversion platform as Applicant's database. Each of the protocol modules are retrieved when a user attempts to communicate with another user that uses a different communication protocol. The conversion platform stores the protocols (within the protocol modules) associated with each user and enables establishment of connection between users based on the particular messaging protocol.

2> The second Rubin declaration ["Rubin-2"] under 37 CFR 1.132 filed August 16, 2007 is sufficient to overcome the rejection of claims 16-20, 22, 103 and 105-151 based upon failing to include essential subject matter. The second Rubin declaration is also sufficient to overcome the rejection of claims 16-20, 22, 103 and 105-151 based on failing to comply with the enablement requirement.

Art Unit: 2152

3> The second Hollaar declaration ["Hollaar-2"] under 37 CFR 1.132 filed August 16, 2007 is insufficient to overcome the rejection of claims 112 and 113 based upon Auerbach. Hollaar-2 merely discloses that his previous statements referring to "the present invention" merely related to the invention recited in amended claims 112 and 113 and not that of any other claim. There is no additional arguments made in Hollaar-2 and therefore it is insufficient to overcome the rejections.

Response to Arguments

I. THE §102(E) REJECTION OF CLAIMS 112 AND 113 UNDER AUERBACH

Applicant noted that despite being under the §102 header, the rejection stated that claims 112 and 113 were rejected pursuant to 35 U.S.C. §103(a) as being anticipated by Auerbach. The rejection should have stated that the claims were rejected pursuant to 35 U.S.C §102(e) as being anticipated by Auerbach.

Aside from relying on Hollaar (which was addressed above), Applicant presents several alternative arguments as to why the §102(e) rejection was improper. Applicant argues that "analogous" is not the standard for withholding a patent under either §102 or §103. The term "analogous" is replaced in this action with terms that comply with the statutory requirements set forth under §102.

Finally, Applicant argues that Auerbach fails to teach retrieving an instant messaging protocol from a database accessible to the first user. Applicant presumably relies on Hollaar to support this argument because Applicant's remarks provide no analysis why the cited

Art Unit: 2152

elements in Auerbach do not correspond to Applicant's claimed database. Hollaar was addressed above and was insufficient to overcome the rejection.

II. THE §103(A) REJECTION CLAIMS 16-20, 22, 103, 105-111, 118-121 AND 125-127 UNDER ARAVAMUDAN IN VIEW OF GUDJONSSON.

Applicant objects to the use of the term "analogous" in the rejection. This term has been replaced in this action to comply with the requirements under §103. Applicant argues: (a) Hollaar and Rubin are entitled to weight and provide evidence that the §103 rejection is improper; (b) that Examiner's claim interpretation is unreasonable because the terms "as between" does not mean "between"; and (c) the rejection is improper for relying on the Gudjonsson patent rather than Gudjonsson's provisional application.

As to (a), for the reasons set forth above, Hollaar and Rubin were found insufficient to overcome the obviousness rejection. As to (b), there is no substantive difference between "as between the devices" and "between the devices." Both are interpreted, within the context of the claim, as providing encryption of an instant message between a first device that sends the instant message to the second device.

As to (c), Applicant's contention that the provisional application must be cited in the claim rejections is without merit. There is no statutory requirement that the rejection be based on the provisional patent application when the patent application relies on the provisional for an earlier priority date.

The previous action relied on Gudjonsson's provisional application to perfect the filing date for the subject matter relied upon in Gudjonsson's patent application. This showing, that the subject matter relied upon to make the rejection was properly supported by

Art Unit: 2152

the provisional application in compliance with 35 USC §112, first paragraph, is all that is required. See MPEP §2136.03.

The rejection relied upon Gudjonsson's teaching of encrypting messages between devices in a messaging system. The previous action pointed to various portions in the Gudjonsson provisional application that taught exactly this subject matter. For example, the provisional stated "[s]trems established through that service are secure and encrypted, e.g., using the SSH 2.0 protocol" (pg. 4, lines 13-15). Gudjonsson discusses providing secure client communications throughout the provisional (pg. 11, line 21 to pg. 12, line 2; pg. 16, lines 14-19; pg. 26, lines 12-14; pg. 32, lines 13-16). Gudjonsson's provisional thereby properly supports the subject matter relied upon to make the rejection.

III. THE §103(A) REJECTION CLAIMS 114-117 AND 122-124 UNDER ARAVAMUDAN IN VIEW OF SHAH.

As to this rejection, Applicant relies on Rubin and Hollaar. Applicant argues that there is no proper reason to combine and the rejection is based on a mischaracterization of the references. Applicant also asserts that Shah does not disclose an instant message or "as between" as claimed.

It should be noted that Rubin is almost entirely directed towards the Gudjonsson reference. Rubin and Rubin's second declaration do not even mention the Aravamudan and Shah references. Hollaar's argument that Aravamudan was mischaracterized is addressed above and was not found sufficient to overcome the obviousness rejection. Hollaar does not discuss the Shah reference.

As to Applicant's assertion with respect to Shah, Applicant provides no analysis to support their position. Applicant's assertion is merely a conclusory statement with no

Art Unit: 2152

reasoning as to how Applicant has arrived at that conclusion. Examiner can only reply that Aravamudan and Shah do disclose the Applicant's invention as claimed (see previous Office action, pgs. 17-18). Shah teaches encrypting messages that are sent between devices. That is all that is required in the claims.

IV. THE §103(A) REJECTION CLAIMS 16, 22, 105-108, 118, 122 125, AND 149 UNDER AUERBACH IN VIEW OF KIM, FURTHER VIEW OF GUDJONSSON.

Applicant primarily relies on the declarations. Rubin merely discusses the Gudjonsson reference. Rubin was found insufficient to overcome the obviousness rejection as set discussed above. Hollaar discussed the Auerbach references but only with respect to claims 112 and 113 (see Hollaar-2, pg. 1). Hollaar's discussion of Auerbach has no weight with respect to claims 16, 22, 105-108, 118, 122, 125, and 149.

V. THE REMAINING §103 REJECTIONS

As to the rejection of claims 114-117 and 125 as being unpatentable over Auerbach and Kim, in further view of Shah, Applicant relies on the declarations as a showing that the references have been mischaracterized. None of the declarations make this assertion. Rubin was confined to discussing Gudjonsson and Hollaar discussed Auerbach only with respect to claims 112 and 113. Applicant repeats the conclusory statement that Shah does not disclose an instant message or "as between." Again, there is no analysis or support for this conclusion making it difficult to give any response. Shah teaches encrypting messages that are sent between devices. That is all that is required in the claims.

As to the rejection of claims 17-20, 103, 123, 124, 126, and 127 as being unpatentable over Auerbach, Kim, Gudjonsson, and Appleman, Applicant contends, without analysis or support that the rejection is defective for lacking specificity. On page 10, item 14 clearly

Art Unit: 2152

stated that the text of any section not included in the action can be found in a prior action.

The substance of the rejection was set forth in the non-final Office action, filed 4.12.2006.

Applicant also relies on the declarations which have been fully addressed above.

As to the rejection of claims 128-130, 132-134, 136-146, 150, and 151 as being unpatentable over Auerbach in view of Shah, Applicant repeats arguments made above with respect to claims 114-117 and 125. They are found unpersuasive for at least the same reasons set forth above.

As to the rejection of claims 131 and 135 as unpatentable over Auerbach and Shah, in view of DeSimone, Applicant repeats arguments made above with respect to claims 114-117 and 125. They are found unpersuasive for at least the same reasons set forth above.

As to the rejection of claims 147 and 148 as unpatentable over Auerbach and Shah in view of Aravamudan, Applicant repeats arguments made above with respect to claims 114-117 and 125. They are found unpersuasive for at least the same reasons set forth above.

VI. CONCLUSION

Rubin or Hollaar were found insufficient to overcome the obviousness rejection. Rubin-2 was found sufficient to overcome the §112, first paragraph rejections and therefore those rejections are withdrawn. For the reasons set forth above, none of Applicant's arguments as to the claim rejections are found persuasive. Therefore, the claim rejections set forth in the previous action are maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4> Claims 112 and 113 are rejected under 35 U.S.C §102(e) as being anticipated by Auerbach et al, U.S Patent No. 6,549,937 [“Auerbach”].

5> As to claim 112, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising the steps of:

retrieving an instant messaging protocol suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach’s conversion platform 112 reads on Applicant’s claimed database]; and

establishing a connection from said first user to said second user using the instant messaging protocol as part of an instant messaging session [column 7 «line 65» to column 8 «line 40»].

Art Unit: 2152

6> As to claim 113, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising the steps of:

retrieving one of a plurality of instant messaging protocols, the one instant messaging protocol being suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach's conversion platform 112 reads on Applicant's claimed database];

displaying an instant message from said first user to said second user using the instant messaging protocol [column 7 «line 65» to column 8 «line 40»].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7> Claims 16-20, 22, 103, 105-111, and 114-127 are rejected under 35 U.S.C § 103(a) as being unpatentable over Aravamudan et al, U.S Patent No. 6.301.609 ["Aravamudan"], in view of Gudjonsson et al, U.S Patent No. 6.564.261 ["Gudjonsson"].

8> As to claim 16, Aravamudan discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising:

associating said first and second users with a first realm and second realm respectively [Figure 3 «items 184 and 192»], each said realm being accessible via the Internet using a protocol characteristic to said realm [column 5 «lines 32-51» | column 7 «lines 3-20» where : if a PSTN network, for instance, a PSTN exchange number is used], each said user getting access to the Internet via one of a respective first and second device [Figure 2], at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm [column 7 «lines 3-20» | column 12 «lines 9-30»];

determining a current IP address of the second user [column 4 «lines 3-25» | column 9 «lines 50-57»];

establishing a connection between said first and second users using said current IP address and said protocol characteristic as part of an instant messaging session [column 9 «lines 45-57» | column 11 «lines 8-45»].

Aravamudan does not expressly disclose encrypting instant messages. In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting, as between the devices, an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43» where : Gudjonsson discloses brokering communication services between two or more users. Gudjonsson also discloses that each device has encrypted communications to its server.

Therefore, when a first device sends a message to a second device, the message is encrypted between the first device to the server and from the server to the second device]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services

Art Unit: 2152

into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

9> As to claim 17, Aravamudan discloses sending a message to the IM database indicating the corresponding user is online [column 9 «line 64» to column 10 «line 15»].

10> As to claim 18, Aravamudan discloses retrieving said address form said IM database [column 5 «lines 25-31» | column 6 «lines 18-31» | column 9 «lines 49-57»].

11> As to claim 19, Aravamudan discloses sending a connection request from the first to the second device for establishing said instant messaging session [column 9 «lines 10-22»].

12> As to claim 20, Aravamudan discloses generating a response to said connection request by said second device accepting said connection request [column 9 «lines 10-22» | column 10 «lines 37-44» | column 11 «lines 35-45»].

13> As to claim 22, Aravamudan discloses displaying a window on the screen of said first and second devices, said window indicating a list of active users [column 6 «lines 18-31»].

14> As to claim 103, Aravamudan discloses displaying a window with a message area, said message area being used to indicate messages between said users [column 10 «lines 37-41»].

Art Unit: 2152

15> As to claims 105 and 106, Aravamudan discloses a handheld and a palmtop computer [Figure 2].

16> As to claim 107, Aravamudan does not expressly disclose a WebTV device. However, Aravamudan states that his invention is not limited to the disclosed devices, and is relevant to any data or communication devices synchronized with a network means [column 3 «lines 26-37»]. As a WebTV device is well known in the art, it would have been obvious to one of ordinary skill in the art to incorporate such devices into Aravamudan's network communication system to increase the number of devices with which he is compatible. Furthermore, selection of network devices is merely a design choice and does not provide any patentable distinction over the prior art references.

17> As to claim 108, Aravamudan discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between a first user device and a second user device [column 3 «lines 26-52»], each said user device corresponding to a user name [column 6 «lines 50-63.], each said user name corresponding to a different realm [column 6 «lines 27-29 and 50-67» | column 7 «lines 9-20»], each said user device having an Internet protocol address in the realm corresponding to the user name [column 4 «lines 20-25» | column 9 «lines 49-57»].

18> Aravamudan does not expressly disclose encrypting instant messages.

Art Unit: 2152

In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting, as between devices, an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

19> As to claims 109-111, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

20> As to claim 114, Aravamudan discloses an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a first Internet Protocol address, a first user name, and a first realm [column 3 «line 26» to column 4 «line 25»]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [column 3 «line 26» to column 4 «line 25» | column 7 «lines 3-20»];

Aravamudan does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson.

In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

21> As to claims 115-117, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

22> As to claims 118-121, as they do not teach or further define over the previously claimed limitations they are similarly rejected for at least the same reasons set forth above for claims 104 and 108-117.

23> As to claims 122 and 125, Aravamudan discloses said first realm employs a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan discloses a characteristic that marks the user as being in a packet network], said second realm employs a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network], and wherein said first protocol characteristic is different from said second protocol characteristic [PSTN vs. packet network].

Art Unit: 2152

24> As to claims 123, 124, 126 and 127, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and 22.

25> Claims 114-117 and 122-124 are rejected as being unpatentable over Aravamudan, in view of Shah et al, U.S Patent No. 6,606,647 [“Shah”].

26> As to claim 114, Aravamudan discloses an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a first Internet Protocol address, a first user name, and a first realm [column 3 «line 26» to column 4 «line 25»]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [column 3 «line 26» to column 4 «line 25» | column 7 «lines 3-20»];

Aravamudan does not expressly disclose key-encrypted instant messages. Shah is directed towards routing messages to achieve unified communications. Shah discloses sending and receiving key-encrypted instant messages between a first user device and a second user device [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42»] where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending device. These two features strongly imply that the message is encrypted using the encryption key].

Art Unit: 2152

It would have been obvious to one of ordinary skill in the art to modify Aravamudan to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Aravamudan's instant messaging system by providing message encryption.

27> As to claims 115-117, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

28> As to claim 122, Aravamudan discloses said first realm employs a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan discloses a characteristic that marks the user as being in a packet network], said second realm employs a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network], and wherein said first protocol characteristic is different from said second protocol characteristic [PSTN vs. packet network].

29> As to claims 123 and 124, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and

22.

Art Unit: 2152

30> Claims 16, 22, 105-108, 118, 122, 125 and 149 are rejected under 35 U.S.C § 103(a) as being unpatentable over Auerbach in view of Kim, U.S Patent No. 6.490.274 ["Kim"], in further view of Gudjonsson.

31> As to claim 16, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising:

associating said first and second with a first realm and a second realm respectively [column 2 «lines 9-15» : different users, different service providers], each realm being accessible via the Internet using a protocol characteristic to the realm (col. 2, lines 19-28), each said user getting access to the Internet via one of a respective first and second device (fig. 3, client 102), at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm (see fig. 3, protocol services 130 and 132);

establishing a connection between said first and second users [column 7 «line 65» to column 8 «line 27»].

While Auerbach discloses the user logging on to the primary service provider using established logon procedures, and Auerbach does not specifically disclose the steps of determining a current IP address of the second user, and establishing a connection between the first and second users using the current IP address and the protocol characteristic. As discussed previously, the use of IP addresses to connect network users is implicit in Auerbach. Auerbach clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, Auerbach discloses establishing sessions based on the

Art Unit: 2152

email addresses of users [column 1 «lines 46-61»]. It is well known in the art that email addresses are inherently tied to IP addresses.

Auerbach does not expressly disclose encrypting instant messages. In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message, as between devices, during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43» where: Gudjonsson's servers are interpreted as Applicant's "devices"; see also response to Applicant's remarks above]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Auerbach's communication system for the desirable function of having secured transmissions of network messages between users.

Furthermore, the step of searching for IP addresses and utilizing said IP addresses are well known in the art as evidenced by Kim. In similar art, Kim discloses a peer-to-peer telephony system for supplying service using a cable network that discloses when a first or second cable phone initiates a call, the network segment units each have a head end unit that read IP addresses stored in the directory unit based on a received telephone number of a second cable phone and determines a session using an internet protocol from the read IP addresses to set a call path with the first cable phone (see Kim, abstract and col. 4, lines 56-65). It would have been obvious to supplement the system disclosed by Auerbach to include the IP address database taught by Kim in order to allow the user to connect to and engage particularly in instant messaging sessions regardless of their different protocol or service providers used. As Auerbach suggests searching for the email addresses of users to establish

Art Unit: 2152

communication sessions, utilization of Kim's IP address database would have been an obvious modification to the system disclosed by Auerbach.

32> In considering claim 22, Auerbach discloses displaying a window on the screen of the first and second devices, the window indicating a list of active users (see Fig 4B).

33> As to claims 105-107, Auerbach discloses a handheld and palmtop computer [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : "consumer electronics"].

34> As to claim 108, Auerbach discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between a first user device and a second user device [column 1 «lines 46-61»], each said user device corresponding to a user name [Figures 4A, 4B.], each said user name corresponding to a different realm [column 2 «lines 26-32»], each said realm having a protocol characteristic to the realm [Figure 4B | column 2 «lines 26-32»].

Auerbach does not expressly disclose each said user device having an Internet protocol address in the realm corresponding to the user name. As discussed previously, the use of IP addresses to connect network users is implicit in Auerbach. Auerbach clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, Auerbach discloses establishing sessions based on the email addresses of users [column 1

Art Unit: 2152

«lines 46-61»]. It is well known in the art that email addresses are inherently tied to IP addresses.

Auerbach does not expressly disclose encrypting instant messages but see rejection of claim 16 above.

35> As to claims 118, as it does not teach or further define over the previously claimed limitations it is similarly rejected for at least the same reasons set forth above for claims 108 and 112.

36> As to claims 122 and 125, Auerbach discloses said first realm employs a first protocol characteristic, said second realm employs a second protocol characteristic, and wherein said first protocol characteristic is different from said second protocol characteristic [claim 1]

37> As to claim 149, Auerbach discloses said realms comprise Internet service providers [abstract].

38> Claims 114-117 and 125 are rejected as being unpatentable over Auerbach and Kim, in view of Shah.

39> As to claim 114, Auerbach disclose an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a

Art Unit: 2152

first Internet Protocol address, a first user name, and a first realm [Auerbach, claim 1 & Kim, abstract]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [Auerbach, claim 1 & Kim, abstract];

Auerbach does not expressly disclose key-encrypted instant messages.

40> Shah is directed towards routing messages to achieve unified communications. Shah discloses sending and receiving key-encrypted instant messages between a first user device and a second user device [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42» where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending device. These two features strongly imply that the message is encrypted using the encryption key].

It would have been obvious to one of ordinary skill in the art to modify Auerbach to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Auerbach's instant messaging system by providing message encryption.

41> As to claims 115-117, Auerbach discloses a handheld and palmtop computer [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : "consumer electronics"].

Art Unit: 2152

42> As to claim 125, Auerbach discloses said first realm has a protocol and said second realm has a protocol, said protocols being different [claim 1].

43> Claims 17-20, 103, 123, 124, 126 and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach, Gudjonsson and Kim, in view of Appelman, U.S. Patent No. 6,750,881.

44> In considering claim 17, while the combined system of Auerbach and Kim discloses the system substantially as claimed, it does not disclose that sending a message to the IM database indicating the corresponding user is online. Nonetheless, the aforementioned limitation is a well-known feature of instant messaging systems as evidenced by Appelman.

In similar art, Appelman discloses a real time notification system that tracks, for each user, the logon status of selected co-users. Appelman further discloses that when a user logs on the logon system notifies the Buddy List System about the user (i.e. passes the User's ID, address, or screen name to the Buddy List System) (see Appelman col. 6, lines 57-59). It would have been obvious to modify the combined system of Auerbach and Kim to include the steps of sending a message to an IM database indicating the corresponding user is online and the current IP address in order to more accurately track user relationships and maintain knowledge of the users and processes on the system. Therefore, the limitations would have been an obvious modification to the combined system of Auerbach and Kim.

Art Unit: 2152

45> In considering claim 18, the combined system of Auerbach, Kim, and Appelman discloses wherein the step of determining the current P address comprises retrieving the address from the IM database (see Kim col. 4, lines 56-61).

46> In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (see Auerbach col. 11 lines 48-50).

47> In considering claim 20, Auerbach discloses generating a response to the connection request by the second device accepting the connection request (see Auerbach col. 11, lines 1-3).

48> In considering claim 103, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (see Appelman Fig. 9).

49> As to claims 123, 124, 126 and 127, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and 22.

50> Claims 128-130, 132-134, 136-146, 150 and 151 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach, in view of Shah.

Art Unit: 2152

51> As to claims 128 and 129, Auerbach discloses a system for instant messaging, the system including:

a first Internet service provider [abstract : sender and recipient each having different service providers];

a second Internet service provider [abstract : recipient's service provider;

a user name associated with the first Internet service provider [column 5 «lines 49-62»]; and

a second user name associated with the second Internet service provider [column 5 «lines 49-62»];

wherein each said user name corresponds to a respective device enabled to conduct an instant messaging session over the Internet [column 4 «lines 20-33» | column 5 «lines 49-62»].

Auerbach does not expressly disclose that said instant messaging session is encrypted as between the devices or that the devices are enabled by a prior communication of an encryption key.

52> Shah is directed towards routing messages to achieve unified communications. Shah discloses sending an receiving key-encrypted instant messages between a first user device and a second user device, the encryption key being sent in a prior communication [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42» where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending

Art Unit: 2152

device. These two features strongly imply that the message is encrypted using the encryption key].

It would have been obvious to one of ordinary skill in the art to modify Auerbach to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Auerbach's instant messaging system by providing message encryption.

53> As to claims 130 and 134, Auerbach discloses the instant messaging session facilitated by forming a relay connection [column 4 «lines 34-50»].

54> As to claims 132, 133, 136, 137, Auerbach discloses a portal instant messaging provider and a general instant messaging provider [column 5 «lines 11-37»].

55> As to claims 138-143 Auerbach discloses handheld and palmtop computers [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : "consumer electronics"].

56> As to claim 144, Auerbach discloses the system further including:
a third Internet service provider [column 5 «lines 16-20»]; and
a third user device associated with a user name at the third Internet service provider, wherein the third user device participates in the instant messaging session [column 5 «lines 11-62»].

Art Unit: 2152

Auerbach does not expressly disclose that said instant messaging session is encrypted as between the devices but see rejection of claim 128 above.

57> As to claim 145, Auerbach discloses the first device displays a friends list including the Internet service provider of the second user and a user name of the second user and the Internet service provider of the third user and the user name of the third user [column 5 «lines 54-59» | column 6 «lines 14-42»].

58> As to claim 146, Auerbach discloses retrieving an instant messaging protocol suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach's conversion platform 112 reads on Applicant's claimed database].

59> As to claims 150 and 151, see rejection of claims 128 above.

60> Claims 131 and 135 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach and Shah in view of DeSimone et al, U.S Patent No. 6,212,548 ["DeSimone"].

61> As to claims 131 and 135, Auerbach does not teach peer-to-peer connections but does teach that the invention may be practiced in "distributed computing environments."

DeSimone discloses establishing peer-to-peer connections for instant messaging [Figure 2B | Figure 3 | column 4 «line 57» to column 5 «line 5»]. It would have been obvious to incorporate

Art Unit: 2152

peer-to-peer methodology into Auerbach's instant messaging system as taught by DeSimone.

One would have been motivated to provide such a combination as peer-to-peer messaging reduces burden on servers [see DeSimone, abstract].

62> Claims 147 and 148 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach and Shah, in view of Aravamudan.

63> As to claim 147 and 148, Auerbach does not expressly disclose a service provider providing Internet telephone service.

64> Aravamudan discloses an internet service provider providing Internet telephone service and establishing a connection with an Internet service provider that provides Internet telephone service [column 3 «lines 26-66» : "Internet Protocol (IP) telephony" | column 4 «lines 6-25»]. It would have been obvious to one of ordinary skill in the art to incorporate IP telephony devices and service providers into Auerbach's unified messaging system as IP telephony and telephony service providers were well known at the time of Auerbach's invention [see Aravamudan, column 1 «lines 37-39»]. One would have been motivated to provide such a combination so as to increase the functionality of Auerbach's system.

Art Unit: 2152

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ANDREW CALDWELL
ADVISORY PATENT EXAMINER

65> DC